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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/719,221	11/21/2003	Gregory S. Blank	P1065R1C3	3185

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EXAMINER

SAUNDERS, DAVID A

ART UNIT

PAPER NUMBER

1644

DATE MAILED: 11/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.



Art Unit: 1644

Claims 1-11 are pending. Claims 1-11 are under examination.

The disclosure is objected to because of the following informalities:

At page 1, line 10, the status of the cross-referenced, prior application must be updated.

Appropriate correction is required.

Claims 4-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 4 and 5 it is improper to refer to "the hydrophobic electrolyte solvent" as TMAC or TEAC, respectively. These substances would be properly recited as --the hydrophobic electrolyte--, rather than as the "solvent" thereof. See teachings at specification page 4, lines 5-11.

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 1-11 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-11 of prior U.S. Patent No. 6,333,398. This is a double patenting rejection.

Instant claims 1-3 and 6-11 are verbatim duplicates of issued claims 1-3 and 6-11. Instant claims 4-5 are essentially the same, but for unclear language, as issued claims 4-5; as such instant claims 4-5 are considered to be de facto duplicates.

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The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1 and 4-11 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of U.S. Patent No. 6,797,814. Although the conflicting claims are not identical, they are not patentably distinct from each other because instant claims 1 and 4-11 read the same as issued claims 1-9, but for the fact that the latter are limited to a method of particularly purifying an anti-HER2 antibody (note that any full size antibody inherently contains a CH2/CH3 region). Since the instant claims, which are generic with respect to the particular species of CH2/CH3 region containing protein being purified, would encompass purification of an anti-HER2 antibody, a disclaimer is required to assure that the '814 patent and any issued instantly shall remain commonly owned.

Any inquiry concerning this communication from the examiner should be directed to David A Saunders, PhD whose telephone number is 571-272-0849.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan, can be reached on 571-272-0841. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Typed 11/9/04 DAS

*David A. Saunders*  
DAVID SAUNDERS  
PRIMARY EXAMINER  
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